

## ABSTRACT

In one aspect the invention provides a method for laser induced breakdown of a material with a pulsed laser beam where the material is characterized by a relationship of fluence breakdown threshold ( $F_{th}$ ) versus laser beam pulse width (T) that exhibits an abrupt, rapid, and distinct change or at least a clearly detectable and distinct change in slope at a predetermined laser pulse width value. The method comprises generating a beam of laser pulses in which each pulse has a pulse width equal to or less than the predetermined laser pulse width value. The beam is focused to a point at or beneath the surface of a material where laser induced breakdown is desired.

The beam may be used in combination with a mask in the beam path. The beam or mask may be moved in the x, y, and Z directions to produce desired features. The technique can produce features smaller than the spot size and Rayleigh range due to enhanced damage threshold accuracy in the short pulse regime.

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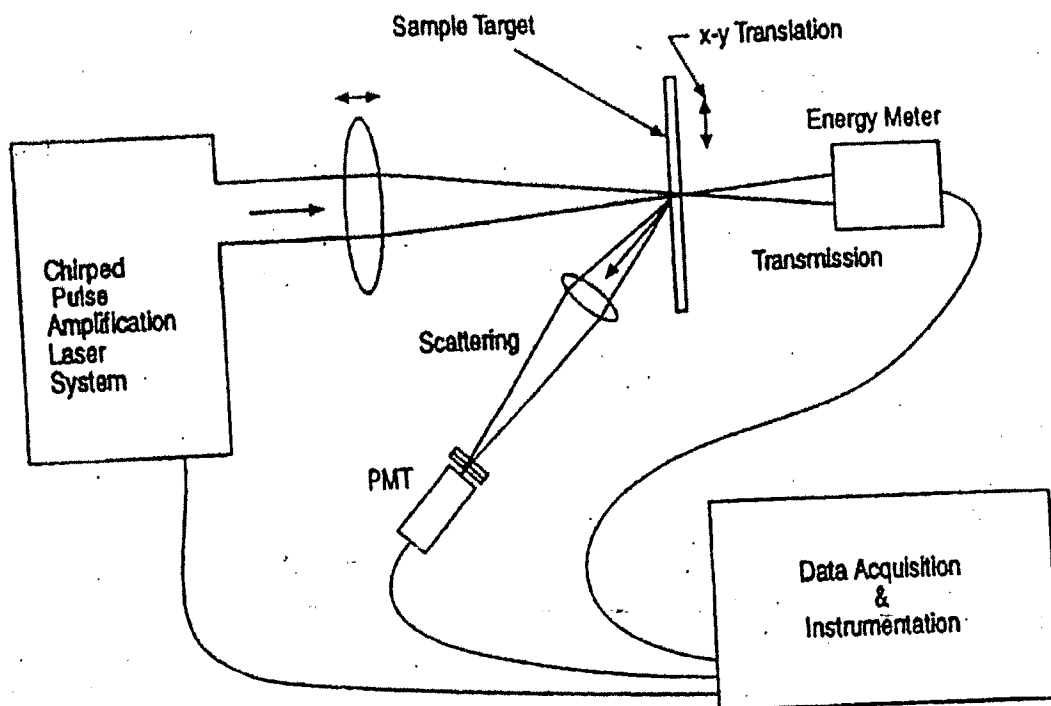


FIG. 1

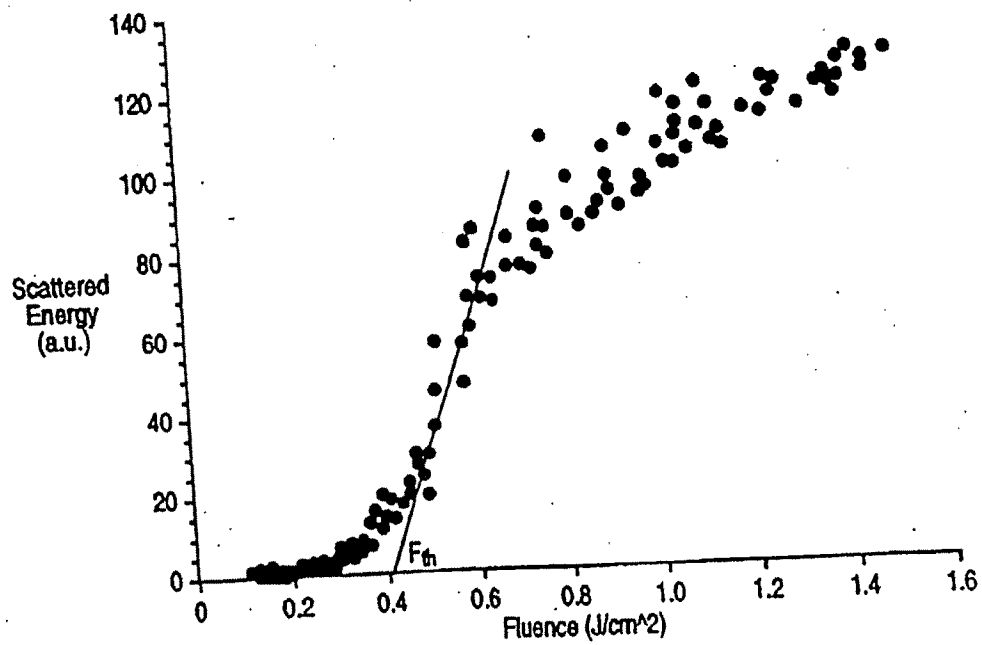


FIG. 2

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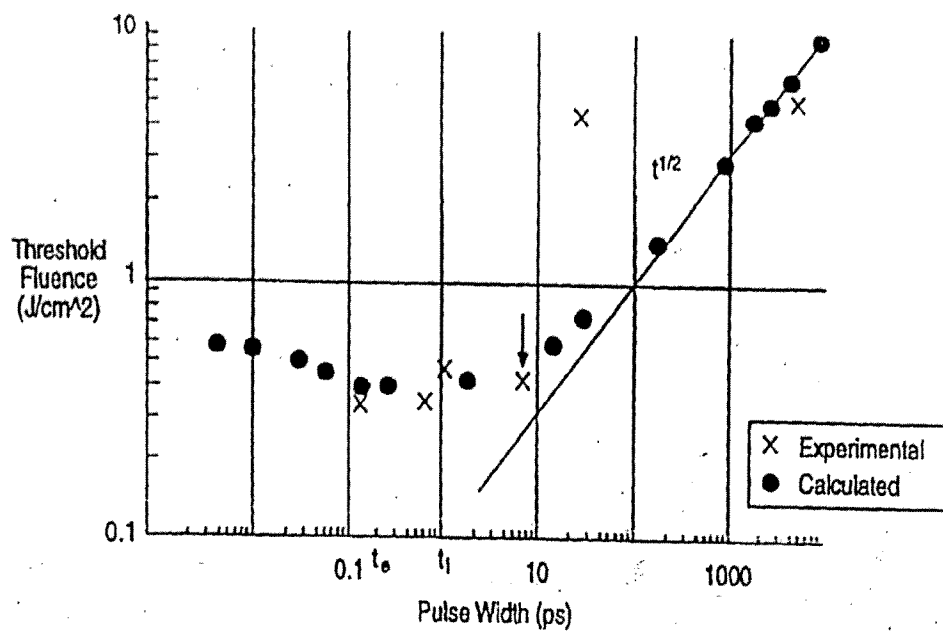


FIG. 3

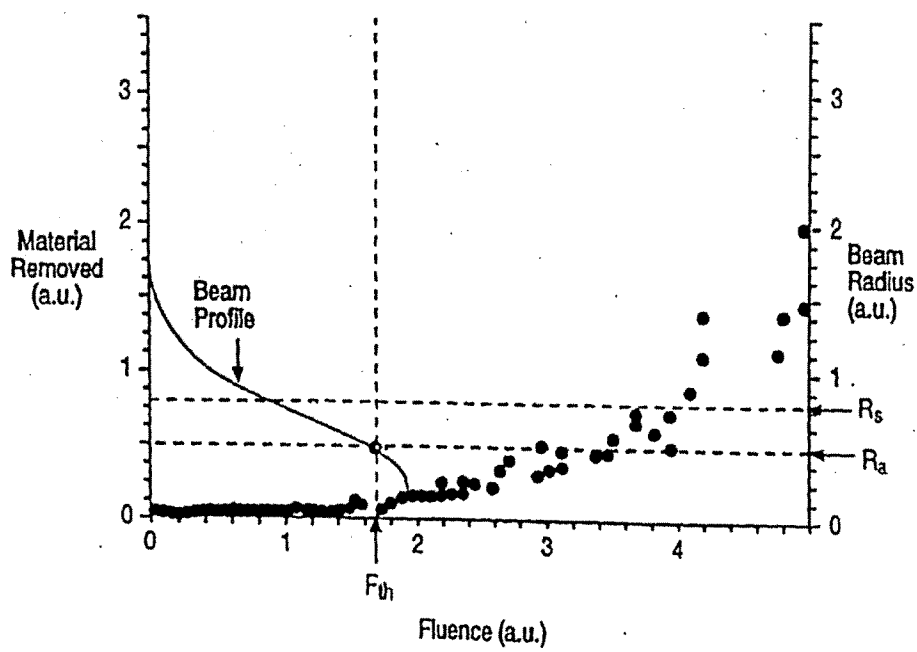


FIG. 4

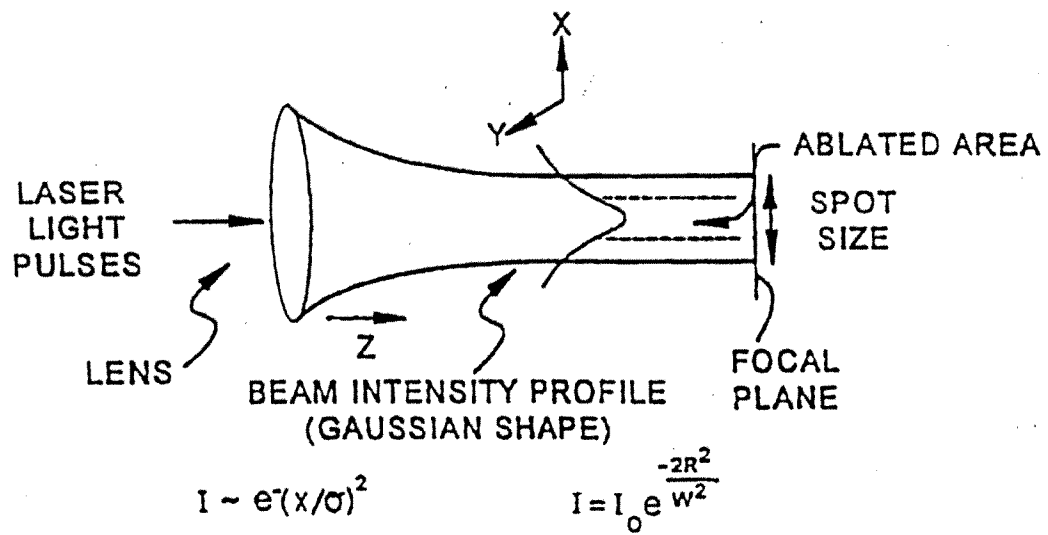
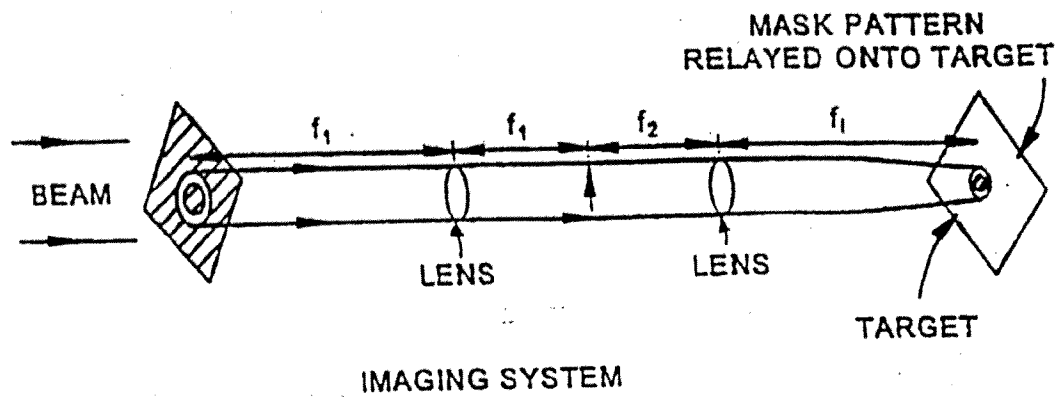


FIG.5

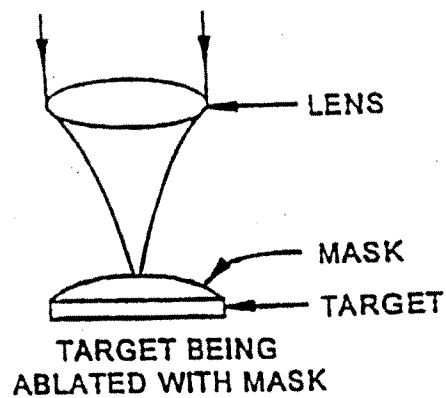
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$f_1, f_2$  - FOCAL LENGTH OF LENSES  
 $f_1 = mf_2$  WHERE  $m$  IS ARBITRARY



MASK - CROSS HATCHED AREAS  
ARE OPAQUE TO LASER WAVELENGTH

FIG.6A



TARGET AFTER ABLATION IS ESSENTIALLY  
IMAGE OF MASK.

FIG.6B

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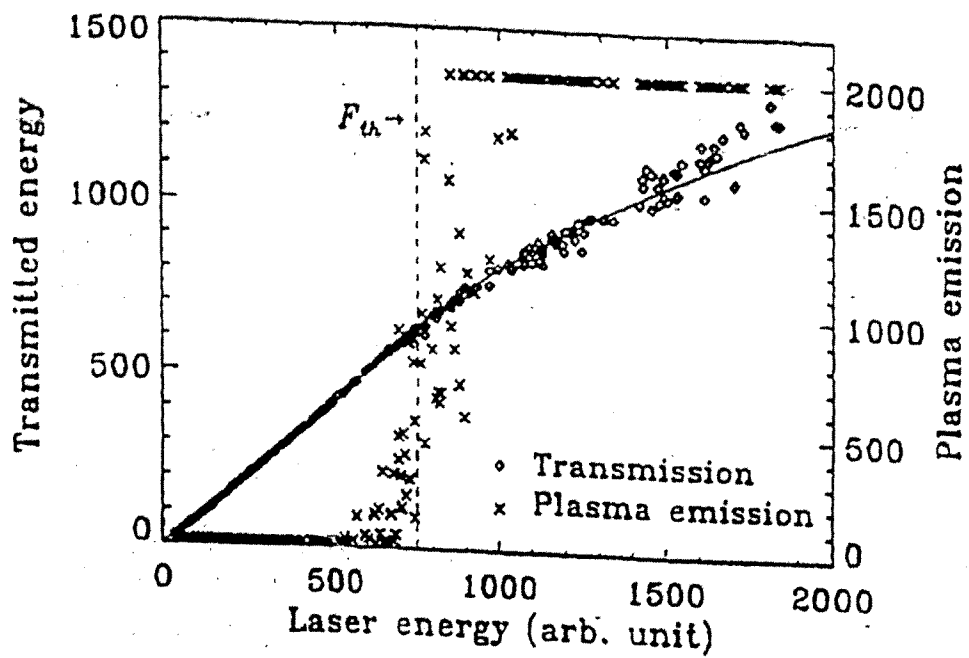


FIGURE 7

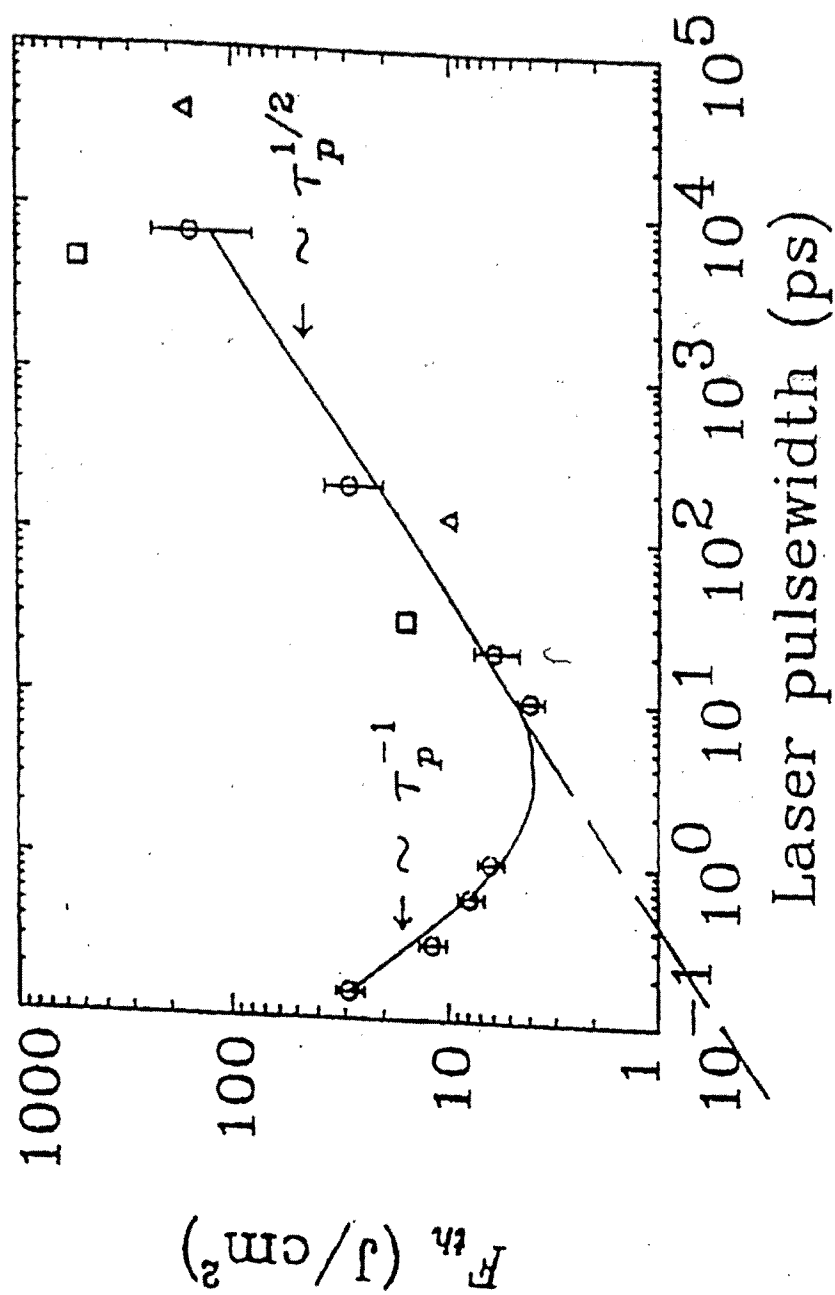


FIGURE 8

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# DAMAGE THRESHOLD FOR CORNEA

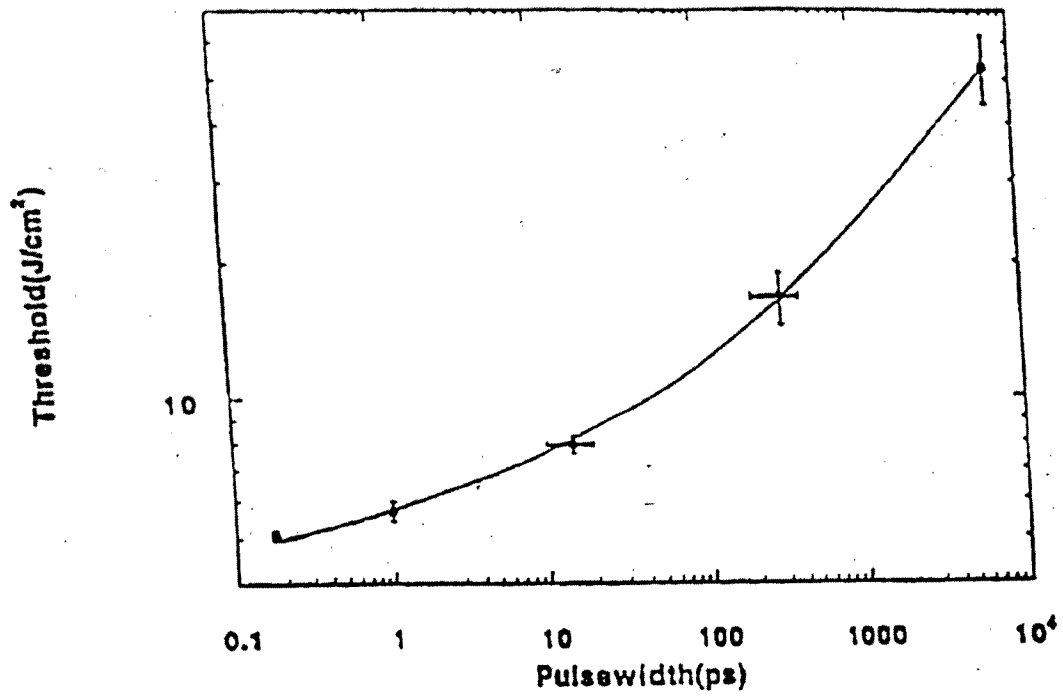


FIGURE 9



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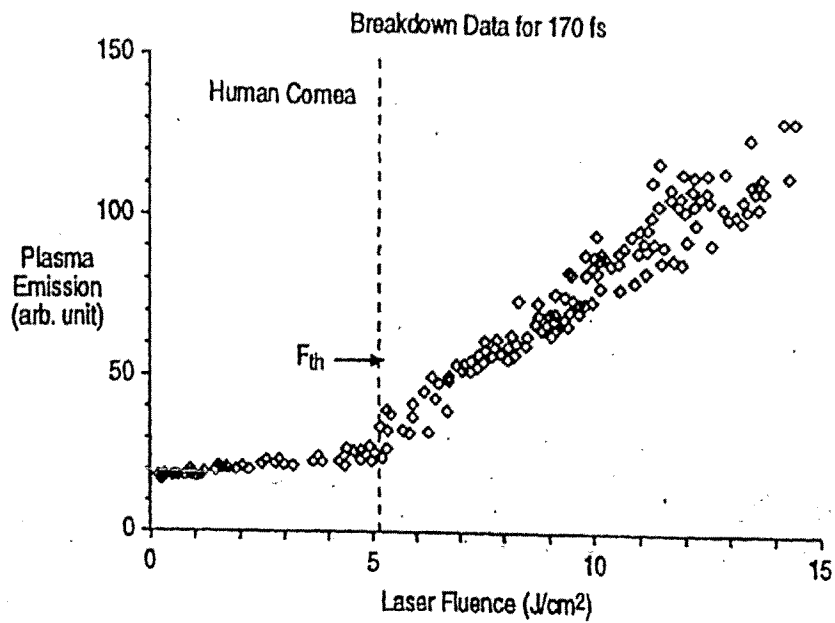


FIG. 10

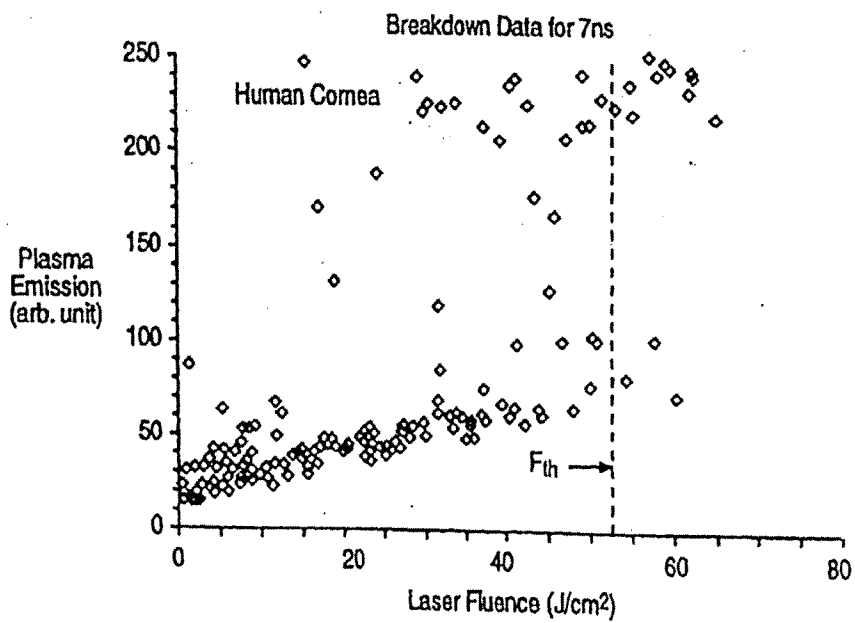


FIG. 11

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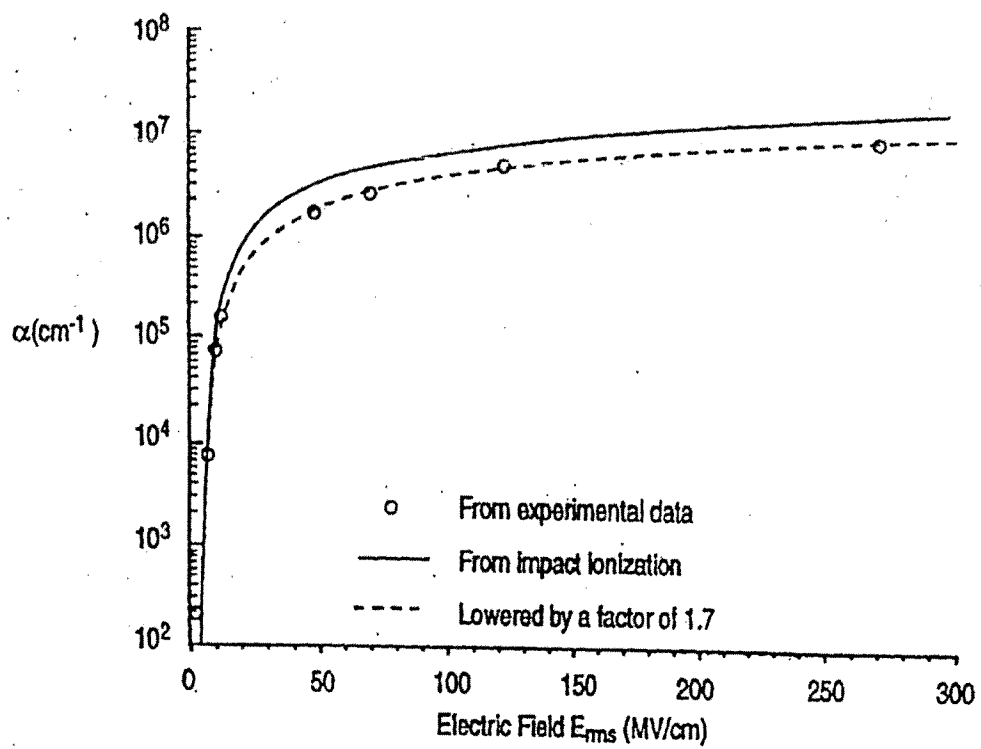


FIG.12

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# DAMAGE ALONG THE Z AXIS

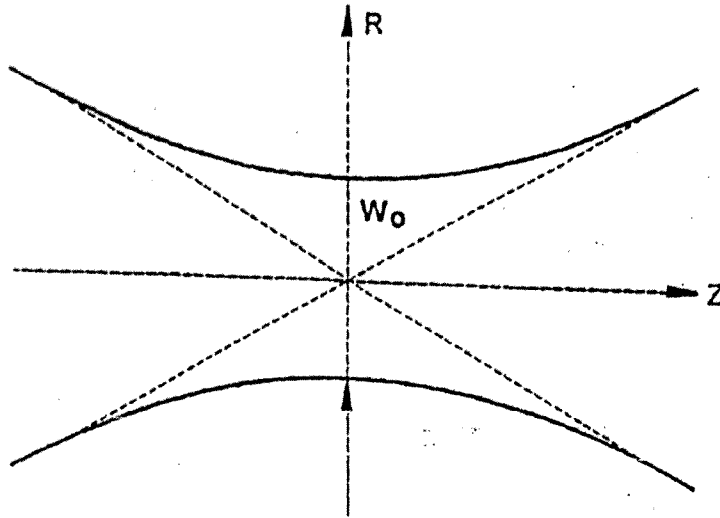


FIG.13A

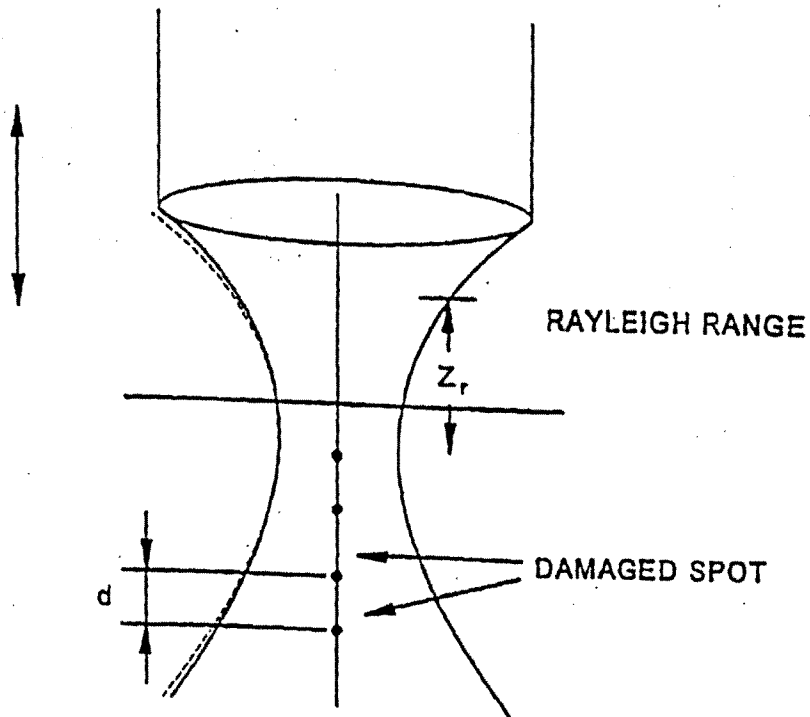


FIG.13B

inequitable conduct or violation of the duty of disclosure, the rejection should be withdrawn. Alternatively, if applicant argues that the admission noted by the examiner was not in fact an admission, the rejection should also be withdrawn.

Form paragraph 14.21.09 should be used where the examiner becomes aware of a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant **independently of the record of the case**, i.e., the examiner has external knowledge of the judicial determination.

Form paragraph 14.22 should be used where, **in the application record**, there is (a) an explicit, unequivocal admission by applicant of fraud, inequitable conduct or violation of the duty of disclosure which is not subject to other interpretation, or (b) information as to a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant. External information which the examiner believes to be an *admission* by applicant should never be used by the examiner, and such external information should never be made of record in the reissue application.

¶ 14.21.09 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention - External Knowledge

Claims [1] rejected under 35 U.S.C. 251 since error “without any deceptive intention” has not been established. In view of the judicial determination in [2] of [3] on the part of applicant, a conclusion that any error was “without deceptive intention” cannot be supported. [4]

#### Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, list the Court or administrative body which made the determination of fraud or inequitable conduct on the part of applicant.
3. In bracket 3, insert --fraud--, --inequitable conduct-- and/or --violation of duty of disclosure--.
4. In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the determination of fraud, inequitable conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.

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¶ 14.22 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention-Evidence in the Application

Claims [1] rejected under 35 U.S.C. 251 since error “without any deceptive intention” has not been established. In view of the reply filed on [2], a conclusion that any error was “without deceptive intention” cannot be supported.

[3]

#### Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert the filing date of the reply which provides an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.
3. In bracket 3, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide circumstances why applicant’s statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

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See MPEP § 2012 for additional discussion as to fraud, inequitable conduct or violation of duty of disclosure in a reissue application.

### 1449 Protest Filed in Reissue Where Patent Is in Interference [R-2]

If a protest (see MPEP Chapter 1900) is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Office of Patent Legal Administration (OPLA) before considering the protest and acting on the reissue application.

The OPLA will check to see that:

(A) all parties to the interference are aware of the filing of the reissue; and

(B) the Office does not allow claims in the reissue which are unpatentable over the pending interference count(s), or found unpatentable in the interference proceeding. >After the reissue application has been reviewed by the OPLA, the reissue application with the protest will be returned to the examiner. See MPEP § 1441.01 for a discussion as to protests under 37 CFR 1.291(a) in reissue applications.<

### 1449.01 Concurrent Office Proceedings [R-2]

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#### I. CONCURRENT REEXAMINATION PROCEEDINGS:<

37 CFR 1.565(d) provides that if “a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been

mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings.” \*\* >37 CFR 1.991 provides that if “a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to 37 CFR 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings”.< If an examiner becomes aware that a reissue application and \* >an *ex parte* or *inter partes*< reexamination proceeding are both pending for the same patent, he or she should inform the Technology Center (TC) Special Program Examiner (SPRE) immediately.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the files for the reissue application and the reexamination will be forwarded to the Office of Patent Legal Administration (OPLA) for a decision whether to merge the reissue and the reexamination, or stay one of the two. >(For IFW processing, see IFW Manual.)< See *In re Onda*, 229 USPQ 235 (Comm’r Pat. 1985). See also MPEP § 2285.

>Where a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. 37 CFR § 1.178(b), 37 CFR 1.565(a), and 37 CFR 1.985(a). The patent owner should file in the reissue application, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.178(b) in order to alert the Office of the existence of the reexamination proceeding on the same patent. See MPEP § 1418. In addition, the patent owner should file in the reexamination proceeding, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.565(a) or 1.985(a) (depending on whether the reexamination proceeding is an *ex parte* reexamination proceeding or an *inter partes* reexamination proceeding) to provide a notification to the Office in the reexamination proceeding of the existence of the two concurrent proceedings.

The patent owner may file a petition under 37 CFR 1.182 in a reissue application to merge the reissue application with the reexamination proceeding, or to stay one of the proceedings because of the other. This

petition must be filed after the issuance of the order to reexamine (37 CFR 1.525, 37 CFR 1.931) in the reexamination proceeding. If the petition is filed prior to the reexamination order, it will not be considered, and will be returned to the patent owner by the TC Director. If the petition is filed after the issuance of the order to reexamine, the petition and the files for the reissue application and the reexamination proceeding will be forwarded to OPLA for decision.

## II. CONCURRENT INTERFERENCE PROCEEDINGS:<

If the original patent is involved in an interference, the examiner must consult the administrative patent judge in charge of the interference before taking any action on the reissue application. It is particularly important that the reissue application not be granted without the administrative patent judge's approval. See MPEP § 2360.

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## III. CONCURRENT REISSUE PROCEEDINGS

Where more than one reissue applications are pending concurrently on the same patent, see MPEP §§ 1450 and 1451.<

### 1449.02 Interference in Reissue

In appropriate circumstances, a reissue application may be placed into interference with a patent or pending application. A patentee may provoke an interference with a patent or pending application by filing a reissue application, if the reissue application includes an appropriate reissue error as required by 35 U.S.C. 251. Reissue error must be based upon applicant error; a reissue cannot be based solely on the error of the Office for failing to declare an interference or to suggest copying claims for the purpose of establishing an interference. See *In re Keil*, 808 F.2d 830, 1 USPQ2d 1427 (Fed. Cir. 1987); *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); *In re Bostwick*, 102 F.2d 886, 888, 41 USPQ 279, 281 (CCPA 1939); and *In re Guastavino*, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936). See also *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 48 USPQ2d 1055 (Fed. Cir. 1998) (Two patents issued claiming the same patentable subject matter, and the patentee with the earlier filing date requested reexamination of the

patent with the later filing date (Slip Track's patent). A stay of litigation in a priority of invention suit under 35 U.S.C. 291, pending the outcome of the reexamination, was reversed. The suit under 35 U.S.C. 291 was the only option available to Slip Track to determine priority of invention. Slip Track could not file a reissue application solely to provoke an interference proceeding before the Office because it did not assert that there was any error as required by 35 U.S.C. 251 in the patent.). A reissue application can be employed to provoke an interference if the reissue application:

(A) adds copied claims which are not present in the original patent;

(B) amends claims to correspond to those of the patent or application with which an interference is sought; or

(C) contains at least one error (not directed to provoking an interference) appropriate for the reissue.

In the first two situations, the reissue oath/declaration must assert that applicant erred in failing to include claims of the proper scope to provoke an interference in the original patent application. Note that in *In re Metz*, 1998 U.S. App. LEXIS 23733 (Fed. Cir. 1998)(unpublished), the Federal Circuit permitted a patentee to file a reissue application to copy claims from a patent in order to provoke an interference with that patent. Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under 35 U.S.C. 112, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959).

A reissue applicant cannot present added or amended claims to provoke an interference, if the claims were deliberately omitted from the patent. If there is evidence that the claims were not inadvertently omitted from the original patent, e.g., the subject matter was described in the original patent as being undesirable, the reissue application may lack proper basis for the reissue. See *In re Bostwick*, 102 F.2d at 889, 41 USPQ at 282 (CCPA 1939)(reissue lacked a proper basis because the original patent pointed out the disadvantages of the embodiment that provided support for the copied claims).

The issue date of the patent, or the publication date of the application publication (whichever is applicable

under 35 U.S.C. 135(b)), with which an interference is sought must be less than 1 year prior to the presentation of the copied or amended claims in the reissue application. See 35 U.S.C. 135(b) and MPEP § 715.05 and § 2307. If the reissue application includes broadened claims, the reissue application must be filed within two years from the issue date of the original patent. See 35 U.S.C. 251 and MPEP § 1412.03.

## REISSUE APPLICATION FILED WHILE PATENT IS IN INTERFERENCE

If a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant is required to notify the Board of Patent Appeals and Interferences of the filing of the reissue application within 10 days from the filing date. See 37 CFR 1.660(b) and MPEP § 2360.

## 1450 Restriction and Election of Species >Made in Reissue Application< [R-2]

37 CFR 1.176. Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application. See MPEP §§ 806 through 806.05(i). The authority to make a "restriction" requirement under 37 CFR 1.176(b) extends to and includes the authority to make an election of species.

¶ 14.21.09 *Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention - External Knowledge*

Claims [1] rejected under 35 U.S.C. 251 since error “without any deceptive intention” has not been established. In view of the judicial determination in [2] of [3] on the part of applicant, a conclusion that any error was “without deceptive intention” cannot be supported. [4]

**Examiner Note:**

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, list the Court or administrative body which made the determination of fraud or inequitable conduct on the part of applicant.
3. In bracket 3, insert --fraud--, --inequitable conduct-- and/or --violation of duty of disclosure--.
4. In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the determination of fraud, inequitable conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.

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¶ 14.22 *Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention-Evidence in the Application*

Claims [1] rejected under 35 U.S.C. 251 since error “without any deceptive intention” has not been established. In view of the reply filed on [2], a conclusion that any error was “without deceptive intention” cannot be supported.

[3]

**Examiner Note:**

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert the filing date of the reply which provides an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.
3. In bracket 3, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide circumstances why applicant's statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

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See MPEP § 2012 for additional discussion as to fraud, inequitable conduct or violation of duty of disclosure in a reissue application.

## 1449 Protest Filed in Reissue Where Patent Is in Interference [R-3]

If a protest (see MPEP Chapter 1900) is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Office of Patent Legal

Administration (OPLA) before considering the protest and acting on the reissue application.

The OPLA will check to see that:

(A) all parties to the interference are aware of the filing of the reissue; and

(B) the Office does not allow claims in the reissue which are unpatentable over the pending interference count(s), or found unpatentable in the interference proceeding. After the reissue application has been reviewed by the OPLA, the reissue application with the protest will be returned to the examiner. See MPEP § 1441.01 for a discussion as to protests under 37 CFR 1.291\* in reissue applications.

## 1449.01 Concurrent Office Proceedings [R-5]

### I. CONCURRENT REEXAMINATION PROCEEDINGS:

37 CFR 1.565(d) provides that if “a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings.” 37 CFR 1.991 provides that if “a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to 37 CFR 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings”. If an examiner becomes aware that a reissue application and an *ex parte* or *inter partes* reexamination proceeding are both pending for the same patent, he or she should >immediately< inform the Technology Center (TC) >or Central Reexamination Unit (CRU)< Special Program Examiner (SPRE)\*.

Pursuant to 37 CFR 1.177, a patent owner may file more than one reissue application for the same patent. If an examiner becomes aware that multiple reissue applications are pending for the same patent, and an *ex parte* or *inter partes* reexamination proceeding is pending for the same patent, he or she should >immediately< inform the TC SPRE\*.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the Office of Patent

Legal Administration (OPLA) must be notified that the proceedings are ready for a decision as to whether to merge the reissue and the reexamination, or stay one of the two. See MPEP § 2285 for the procedure of notifying OPLA and general guidance, if a reissue application and an *ex parte* reexamination proceeding are both pending for the same patent, and an *inter partes* reexamination proceeding is not involved. See MPEP § 2686.03 where a reissue application and an *inter partes* reexamination proceeding are both pending for the same patent, regardless of whether an *ex parte* reexamination proceeding is also pending.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. 37 CFR § 1.178(b), 37 CFR 1.565(a), and 37 CFR 1.985(a). The patent owner should file in the reissue application, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.178(b) in order to alert the Office of the existence of the reexamination proceeding on the same patent. See MPEP § 1418. In addition, the patent owner should file in the reexamination proceeding, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.565(a) or 1.985(a) (depending on whether the reexamination proceeding is an *ex parte* reexamination proceeding or an *inter partes* reexamination proceeding) to provide a notification to the Office in the reexamination proceeding of the existence of the two concurrent proceedings.

The patent owner may file a petition under 37 CFR 1.182 in a reissue application to merge the reissue application with the reexamination proceeding, or to stay one of the proceedings because of the other. This petition must be filed after the issuance of the order to reexamine (37 CFR 1.525, 37 CFR 1.931) in the reexamination proceeding. If the petition is filed prior to the reexamination order, it will not be considered, and will be returned to the patent owner by the TC >or CRU< Director. If the petition is filed after the issuance of the order to reexamine, the petition and the files for the reissue application and the reexamination proceeding will be forwarded to OPLA for decision.

## II. CONCURRENT INTERFERENCE PROCEEDINGS

If the original patent is involved in an interference, the examiner must consult the administrative patent judge in charge of the interference before taking any action on the reissue application. It is particularly important that the reissue application not be granted without the administrative patent judge's approval. See MPEP Chapter 2300.

## III. CONCURRENT REISSUE PROCEEDINGS

Where more than one reissue applications are pending concurrently on the same patent, see MPEP §§ 1450 and 1451.

### 1449.02 Interference in Reissue [R-5]

#### 37 CFR 41.8. Mandatory notices.

(a) In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

- (1) Its real party-in-interest, and
- (2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

#### 37 CFR 41.202. Suggesting an interference.

(a) *Applicant.* An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

- (1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,
- (2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,
- (3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),
- (4) Explain in detail why the applicant will prevail on priority,
- (5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and
- (6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

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(c) *Examiner.* An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102 (g):

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

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In appropriate circumstances, a reissue application may be placed into interference with a patent or pending application. A patentee may provoke an interference with a patent or pending application by filing a reissue application, if the reissue application includes an appropriate reissue error as required by 35 U.S.C. 251. Reissue error must be based upon applicant error; a reissue cannot be based solely on the error of the Office for failing to declare an interference or to suggest copying claims for the purpose of establishing an interference. See *In re Keil*, 808 F.2d 830, 1 USPQ2d 1427 (Fed. Cir. 1987); *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); *In re Bostwick*, 102 F.2d 886, 888, 41 USPQ 279, 281 (CCPA 1939); and *In re Guastavino*, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936). See also *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 48 USPQ2d 1055 (Fed. Cir. 1998) (Two patents issued claiming the same patentable subject matter, and the patentee with the earlier filing date requested reexamination of the patent with the later filing date (Slip Track's patent). A stay of litigation in a priority of invention suit under 35 U.S.C. 291, pending the outcome of the reexamination, was reversed. The suit under 35 U.S.C. 291 was the only option available to Slip Track to determine priority of invention. Slip Track could not file a reissue application solely to provoke an interference proceeding before the Office because it did not assert that there was any error as required by 35 U.S.C. 251 in the patent.). A reissue application can be employed to provoke an interference if the reissue application:

(A) adds copied claims which are not present in the original patent;

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(C) contains at least one error (not directed to provoking an interference) appropriate for the reissue.

In the first two situations, the reissue oath/declaration must assert that applicant erred in failing to include claims of the proper scope to provoke an interference in the original patent application. Note that in *In re Metz*, 173 F.3d 433 (Fed. Cir. 1998) (table), the Federal Circuit permitted a patentee to file a reissue application to copy claims from a patent in order to provoke an interference with that patent. Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under 35 U.S.C. 112, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959).

A reissue applicant cannot present added or amended claims to provoke an interference, if the claims were deliberately omitted from the patent. If there is evidence that the claims were not inadvertently omitted from the original patent, e.g., the subject matter was described in the original patent as being undesirable, the reissue application may lack proper basis for the reissue. See *In re Bostwick*, 102 F.2d at 889, 41 USPQ at 282 (CCPA 1939) (reissue lacked a proper basis because the original patent pointed out the disadvantages of the embodiment that provided support for the copied claims).

The issue date of the patent, or the publication date of the application publication (whichever is applicable under 35 U.S.C. 135(b)), with which an interference is sought must be less than 1 year prior to the presentation of the copied or amended claims in the reissue application. See 35 U.S.C. 135(b) and MPEP § 715.05 and MPEP Chapter 2300. If the reissue application includes broadened claims, the reissue application must be filed within two years from the issue date of the original patent. See 35 U.S.C. 251 and MPEP § 1412.03.

An examiner may, pursuant to 37 CFR 41.202(c), require a reissue applicant to add a claim to provoke an interference, unless the reissue applicant cannot present the added claim to provoke an interference based upon the provisions of the reissue statute and rules, e.g., if the claim was deliberately omitted from the patent, or if the claim enlarges the scope of the claims of the original patent and was not "applied for within two years from the grant of the original

patent.” Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the reissue applicant must also comply with 37 CFR 41.202(a)(2) through (a)(6). The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g), be patentable to the reissue applicant, and be drawn to patentable subject matter claimed by another applicant or patentee.

#### **REISSUE APPLICATION FILED WHILE \* PATENT IS IN INTERFERENCE**

If a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant must promptly notify the Board of Patent Appeals and Interferences of the filing of the reissue application within 20 days from the filing date. See 37 CFR 41.8 and MPEP Chapter 2300.

### **1450 Restriction and Election of Species >Made in Reissue Application< [R-2]**

#### *37 CFR 1.176. Examination of reissue.*

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application. See MPEP §§ 806 through 806.05(i). The authority to make a “restriction”

requirement under 37 CFR 1.176(b) extends to and includes the authority to make an election of species.

Where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected (except for the limited situation where a disclaimer is filed as discussed in the next paragraph). Thus, the examiner will issue an Office action >in the reissue application< (1) providing notification of the restriction requirement, (2) holding the added claims to be constructively non-elected and withdrawn from consideration, \* (3) treating the original patent claims on the merits>, and (4) informing applicant that if the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.<.

If a disclaimer of all the original patent claims is filed in the reissue application containing newly added claims that are separate and distinct from the original patent claims, only the newly added claims will be present for examination. In this situation, the examiner’s Office action will treat the newly added claims in the reissue application on the merits. The disclaimer of all the original patent claims must be filed in the reissue application prior to the issuance of the examiner’s Office action containing the restriction requirement, in order for the newly added claims to be treated on the merits. Once the examiner has issued the Office action providing notification of the restriction requirement and treating the patent claims on the merits, it is too late to obtain an examination on the added claims in the reissue application by filing a disclaimer of all the original patent claims. If reissue applicant wishes to have the newly added claims be treated on the merits, a divisional reissue application must be filed to obtain examination of the added claims. Reissue applicants should carefully note that once a disclaimer of the patent claims is filed, it cannot be withdrawn. It does not matter whether the reissue application is still pending, or whether the reissue application has been abandoned or issued as a reissue patent. For all these situations, 37 CFR 1.176(b) states that the disclaimer cannot be withdrawn; the disclaimer will be given effect.

Claims elected pursuant to a restriction requirement will receive a complete examination on the merits, while the non-elected claims (to any added inven-

appropriate one of form paragraphs 14.21.09 or 14.22 as reproduced below.

Any admission of fraud, inequitable conduct or violation of the duty of disclosure must be explicit, unequivocal, and not subject to other interpretation. Where a rejection is made based upon such an admission (see form paragraph 14.22 below) and applicant responds with any reasonable interpretation of the facts that would not lead to a conclusion of fraud, inequitable conduct or violation of the duty of disclosure, the rejection should be withdrawn. Alternatively, if applicant argues that the admission noted by the examiner was not in fact an admission, the rejection should also be withdrawn.

Form paragraph 14.21.09 should be used where the examiner becomes aware of a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant **independently of the record of the case**, i.e., the examiner has external knowledge of the judicial determination.

Form paragraph 14.22 should be used where, **in the application record**, there is (a) an explicit, unequivocal admission by applicant of fraud, inequitable conduct or violation of the duty of disclosure which is not subject to other interpretation, or (b) information as to a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant. External information which the examiner believes to be an *admission* by applicant should never be used by the examiner, and such external information should never be made of record in the reissue application.

¶ 14.21.09 *Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention - External Knowledge*

Claims [1] rejected under 35 U.S.C. 251 since error “without any deceptive intention” has not been established. In view of the judicial determination in [2] of [3] on the part of applicant, a conclusion that any error was “without deceptive intention” cannot be supported. [4]

**Examiner Note:**

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, list the Court or administrative body which made the determination of fraud or inequitable conduct on the part of applicant.
3. In bracket 3, insert --fraud--, --inequitable conduct-- and/or --violation of duty of disclosure--.
4. In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the determination of fraud, inequitable

conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.

¶ 14.22 *Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention-Evidence in the Application*

Claims [1] rejected under 35 U.S.C. 251 since error “without any deceptive intention” has not been established. In view of the reply filed on [2], a conclusion that any error was “without deceptive intention” cannot be supported.

[3]

**Examiner Note:**

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert the filing date of the reply which provides an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.
3. In bracket 3, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide circumstances why applicant's statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

See MPEP § 2012 for additional discussion as to fraud, inequitable conduct or violation of duty of disclosure in a reissue application.

## 1449 Protest Filed in Reissue Where Patent Is in Interference [R-3]

If a protest (see MPEP Chapter 1900) is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Office of Patent Legal Administration (OPLA) before considering the protest and acting on the reissue application.

The OPLA will check to see that:

(A) all parties to the interference are aware of the filing of the reissue; and

(B) the Office does not allow claims in the reissue which are unpatentable over the pending interference count(s), or found unpatentable in the interference proceeding. After the reissue application has been reviewed by the OPLA, the reissue application with the protest will be returned to the examiner. See MPEP § 1441.01 for a discussion as to protests under 37 CFR 1.291\* in reissue applications.

## 1449.01 Concurrent Office Proceedings [R-7]

### I. CONCURRENT REEXAMINATION PROCEEDINGS:

37 CFR 1.565(d) provides that if “a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will \*usually< be made to merge the two proceedings or to suspend one of the two proceedings.” 37 CFR 1.991 provides that if “a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to 37 CFR 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings.” If an examiner becomes aware that a reissue application and an *ex parte* or *inter partes* reexamination proceeding are both pending for the same patent, he or she should immediately inform \*his or her< Technology Center (TC) or Central Reexamination Unit (CRU) Special Program Examiner (SPRE) >or appropriate Quality Assurance Specialist (QAS)<.

\*\*>Under< 37 CFR 1.177, a patent owner may file more than one reissue application for the same patent. If an examiner becomes aware that multiple reissue applications are pending for the same patent, and an *ex parte* or *inter partes* reexamination proceeding is pending for the same patent, he or she should immediately inform \*\*>his or her TC or CRU SPRE or appropriate TC QAS<.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the Office of Patent Legal Administration (OPLA) must be notified >(by e-mail to the lead Senior Legal Advisor responsible for reexamination)< that the proceedings are ready for a decision as to whether to merge the reissue and the reexamination, or stay one of the two. See MPEP § 2285 for the procedure of notifying OPLA and general guidance, if a reissue application and an *ex parte* reexamination proceeding are both pending for the same patent, and an *inter partes* reexamination proceeding is not involved. See MPEP § 2686.03 where a reissue application and an *inter partes* reexamination proceeding are both pending for the same patent,

regardless of whether an *ex parte* reexamination proceeding is also pending.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. 37 CFR § 1.178(b), 37 CFR 1.565(a), and 37 CFR 1.985(a). The patent owner should file in the reissue application, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.178(b) in order to alert the Office of the existence of the reexamination proceeding on the same patent. See MPEP § 1418. In addition, the patent owner should file in the reexamination proceeding, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.565(a) or 1.985(a) (depending on whether the reexamination proceeding is an *ex parte* reexamination proceeding or an *inter partes* reexamination proceeding) to provide a notification to the Office in the reexamination proceeding of the existence of the two concurrent proceedings.

The patent owner may file a petition under 37 CFR 1.182 in a reissue application to merge the reissue application with the reexamination proceeding, or to stay one of the proceedings because of the other. This petition must be filed after \*\* the order to reexamine >is issued< (37 CFR 1.525, 37 CFR 1.931) in the reexamination proceeding. If the petition is filed \*\*>before< the reexamination order, it will not be considered, and will be returned to the patent owner by the TC or CRU Director >,or expunged from the record, if entered into the Image File Wrapper (IFW) before discovery that the petition is an improper paper<. If the petition is filed after \*\* the order to reexamine >is issued<, the petition and >any other paper materials for< the files for the reissue application and the reexamination proceeding will be forwarded to OPLA for decision. >An e-mail will be sent to the lead Senior Legal Advisor of OPLA responsible for reexamination, providing notification that the petition is ready to be addressed.

### ***Reexamination Certificate Is To Be Issued for a Patent, While a Reissue Application for the Patent Is Pending***

The following provides guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the

patent is pending and will not be merged with the reexamination. This can occur, for example, where a reissue application prosecution is stayed or suspended, and the prosecution of a reexamination proceeding for the patent (for which reissue is requested) is permitted to proceed. It can also occur where a reissue application is filed after the reexamination proceeding has entered the publication process, such that it is too late to consider the question of stay or merger.

(A) The examiner will not act on the reissue application until the reexamination certificate issues and publishes.

(B) After the reexamination certificate issues and publishes--

At the time that the reexamination certificate is issued and published, the Office will resume examination of the reissue application--

(1) An Office action will be issued giving the patent owner (applicant) one month to submit an amendment of the reissue application claims, based upon the results of the concluded reexamination proceeding.

(2) The reissue application will then be examined. Any claim canceled by the reexamination certificate will be treated the same way as a claim lost in litigation, and stated in the next action to be deemed as canceled. The remaining claims will be examined. If the reissue application is subsequently allowed, the claims that were canceled by the reexamination certificate will be formally canceled in the reissue application by examiner's amendment (unless they have already been canceled by applicant).

It is to be noted that the patent owner/applicant will have been advised in any decision suspending the copending reissue application to bring to the attention of the Office the issuance of the reexamination certificate, request a resumption of examination of the reissue application, and to include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding.

(3) Generally, further prosecution will be limited to claims narrower than those claims canceled by the reexamination certificate. Any claims added thereafter, which are equal in scope to claims canceled by the reexamination certificate, or are broader than the scope of the claims canceled by the reexamination certificate, will generally be deemed as surrendered

based on the patent owner's failure to prosecute claims of equal scope, and to present claims of broader scope in the reexamination proceeding. Such claims will be rejected under 35 U.S.C. 251. Further, a rejection of such claims based on estoppel will be made, citing to MPEP § 2308.03 as to treatment of claims lost in a proceeding before the Office, and noting that a reexamination is a "proceeding."

An exception to the guidance stated in part (3) above: claims that are broader than the scope of the claims canceled by the reexamination certificate may be presented where:

(a) The broader claims in the reissue application can be patentable, despite the fact that the claims in the reexamination are not; and

(b) The broader claims in the reissue application could not have been presented in the reexamination proceeding.

Criterion (a) can occur if the broadened claims in the reissue application have an earlier effective date than those canceled by the reexamination certificate (as where the claims in the reissue application are supported by a parent application, and the reexamination claims are not). Criterion (a) can also occur if the subject matter of the broadened claims in the reissue application can be sworn behind, and the more specific subject matter of the reexamination claims cannot be sworn behind. Criterion (b) can occur if the claims in the reissue application are broader than all claims of the patent as it existed during reexamination (e.g., claims directed to a distinct invention).

(4) What happened in the concluded reexamination proceeding must be taken into account by the examiner as to any new claims presented by the reissue application. This is in addition to any other issue that may be addressed in any reissue application.

(5) If all of the patent claims were canceled by the reexamination certificate, action on the reissue application can still proceed, as will be discussed below; however, patent owner/applicant must first file a petition under 37 CFR 1.183 to waive 37 CFR 1.570 and/or 37 CFR 1.997(d), depending on whether the certificate was issued for an *ex parte* reexamination proceeding, an *inter partes* reexamination proceeding, or a merger of the two. The petition would be grantable where the patent owner/applicant shows that either:

(a) The reissue claims are narrower than those claims canceled by the reexamination certificate; or

(b) Criteria (a) and (b) of part (3) above are satisfied by the claims of the reissue application.

The claims satisfying this requirement may only be provided where a petition accompanies the amendment providing the claims

(C) The reissue application can still proceed even where all of the patent claims were canceled by the reexamination certificate, based on the following. Where the reexamination certificate issues and publishes to cancel all existing patent claims, the reissue application can continue in the Office to correct the 35 U.S.C. 251 “error” of presenting the existing claims, which were in-fact unpatentable. Of course, what happened in the concluded reexamination proceeding must be taken into account by the examiner, as to any new claims presented by the reissue application. See the discussion in part (B)(3)(b) above. If a reissue application is filed after a reexamination certificate issues and publishes to cancel all existing patent claims, then the matter should be forwarded to OPLA for resolution.<

## II. CONCURRENT INTERFERENCE PROCEEDINGS

If the original patent is involved in an interference, the examiner must consult the administrative patent judge in charge of the interference before taking any action on the reissue application. It is particularly important that the reissue application not be granted without the administrative patent judge’s approval. See MPEP Chapter 2300.

## III. CONCURRENT REISSUE PROCEEDINGS

Where more than one reissue applications are pending concurrently on the same patent, see MPEP §§ 1450 and 1451.

### 1449.02 Interference in Reissue [R-7]

#### 37 CFR 41.8. Mandatory notices.

(a) In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

(1) Its real party-in-interest, and

(2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

#### 37 CFR 41.202. Suggesting an interference.

(a) *Applicant.* An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),

(4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant’s specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

\*\*\*\*\*

(c) *Examiner.* An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102 (g):

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

\*\*\*\*\*

In appropriate circumstances, a reissue application may be placed into interference with a patent or pending application. A patentee may provoke an interference with a patent or pending application by filing a reissue application, if the reissue application includes an appropriate reissue error as required by 35 U.S.C. 251. Reissue error must be based upon applicant error; a reissue cannot be based solely on the error of the Office for failing to declare an interference or to suggest copying claims for the purpose of establishing

an interference. See *In re Keil*, 808 F.2d 830, 1 USPQ2d 1427 (Fed. Cir. 1987); *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); *In re Bostwick*, 102 F.2d 886, 888, 41 USPQ 279, 281 (CCPA 1939); and *In re Guastavino*, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936). See also *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 48 USPQ2d 1055 (Fed. Cir. 1998) (Two patents issued claiming the same patentable subject matter, and the patentee with the earlier filing date requested reexamination of the patent with the later filing date (Slip Track's patent). A stay of litigation in a priority of invention suit under 35 U.S.C. 291, pending the outcome of the reexamination, was reversed. The suit under 35 U.S.C. 291 was the only option available to Slip Track to determine priority of invention. Slip Track could not file a reissue application solely to provoke an interference proceeding before the Office because it did not assert that there was any error as required by 35 U.S.C. 251 in the patent.). A reissue application can be employed to provoke an interference if the reissue application:

(A) adds copied claims which are not present in the original patent;

(B) amends claims to correspond to those of the patent or application with which an interference is sought; or

(C) contains at least one error (not directed to provoking an interference) appropriate for the reissue.

In the first two situations, the reissue oath/declaration must assert that applicant erred in failing to include claims of the proper scope to provoke an interference in the original patent application>, and must include an identification of the claims added to provoke the interference<. Note that in *In re Metz*, 173 F.3d 433 (Fed. Cir. 1998) (table), the Federal Circuit permitted a patentee to file a reissue application to copy claims from a patent in order to provoke an interference with that patent. Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under 35 U.S.C. 112, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959).

A reissue applicant cannot present added or amended claims to provoke an interference, if the claims were deliberately omitted from the patent. If

there is evidence that the claims were not inadvertently omitted from the original patent, e.g., the subject matter was described in the original patent as being undesirable, the reissue application may lack proper basis for the reissue. See *In re Bostwick*, 102 F.2d at 889, 41 USPQ at 282 (CCPA 1939)(reissue lacked a proper basis because the original patent pointed out the disadvantages of the embodiment that provided support for the copied claims).

The issue date of the patent, or the publication date of the application publication (whichever is applicable under 35 U.S.C. 135(b)), with which an interference is sought must be less than 1 year \*\*>before< the presentation of the copied or amended claims in the reissue application. See 35 U.S.C. 135(b) and MPEP § 715.05 and MPEP Chapter 2300. If the reissue application includes broadened claims, the reissue application must be filed within two years from the issue date of the original patent. See 35 U.S.C. 251 and MPEP § 1412.03.

An examiner may, pursuant to 37 CFR 41.202(c), require a reissue applicant to add a claim to provoke an interference, unless the reissue applicant cannot present the added claim to provoke an interference based upon the provisions of the reissue statute and rules, e.g., if the claim was deliberately omitted from the patent, or if the claim enlarges the scope of the claims of the original patent and was not “applied for within two years from the grant of the original patent.” Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the reissue applicant must also comply with 37 CFR 41.202(a)(2) through (a)(6). The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g), be patentable to the reissue applicant, and be drawn to patentable subject matter claimed by another applicant or patentee.

## REISSUE APPLICATION FILED WHILE PATENT IS IN INTERFERENCE

If a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant must promptly notify the Board of Patent Appeals and Interferences of the filing of the reissue



application within 20 days from the filing date. See 37 CFR 41.8 and MPEP Chapter 2300.

## 1450 Restriction and Election of Species Made in Reissue Application [R-7]

*37 CFR 1.176. Examination of reissue.*

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application. See MPEP §§ 806 through 806.05(i). The authority to make a “restriction” requirement under 37 CFR 1.176(b) extends to and includes the authority to make an election of species. >For reissue applications of patents issued from a U.S. national stage application submitted under 35 U.S.C. 371, the “restriction” requirement should not be made under the PCT unity of invention standard as set forth in MPEP Chapter 1800, because a reissue application is filed under 35 U.S.C. 251, and not under 35 U.S.C. 371.<

Where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected (except for the limited situation where a disclaimer is filed as discussed in the next paragraph). Thus, the examiner will issue an Office action in the reissue application (1) providing notification of the restriction requirement, (2) holding the added claims to be constructively non-elected and withdrawn from consideration, (3) treating the original patent claims on the merits, and (4) informing

applicant that if the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.

If a disclaimer of all the original patent claims is filed in the reissue application containing newly added claims that are separate and distinct from the original patent claims, only the newly added claims will be present for examination. In this situation, the examiner’s Office action will treat the newly added claims in the reissue application on the merits. The disclaimer of all the original patent claims must be filed in the reissue application ~~\*\*>~~before< the issuance of the examiner’s Office action containing the restriction requirement, in order for the newly added claims to be treated on the merits. Once the examiner has issued the Office action providing notification of the restriction requirement and treating the patent claims on the merits, it is too late to obtain an examination on the added claims in the reissue application by filing a disclaimer of all the original patent claims. If reissue applicant wishes to have the newly added claims be treated on the merits, a divisional reissue application must be filed to obtain examination of the added claims. Reissue applicants should carefully note that once a disclaimer of the patent claims is filed, it cannot be withdrawn. It does not matter whether the reissue application is still pending, or whether the reissue application has been abandoned or issued as a reissue patent. For all these situations, 37 CFR 1.176(b) states that the disclaimer cannot be withdrawn; the disclaimer will be given effect.

Claims elected pursuant to a restriction requirement will receive a complete examination on the merits, while the non-elected claims (to any added invention(s)) will be held in abeyance in a withdrawn status, and will only be examined if filed in a divisional reissue application. If the reissue application containing only original unamended claims becomes allowable first (and no “error” under 35 U.S.C. 251 exists), further action in that reissue application will be suspended to await examination in the divisional reissue application(s) containing the added claims. Multiple suspensions (usually six-month periods) may be necessary. The Office will not permit claims to issue in a reissue application which application does not correct any error in the original patent. Once a